

**Remarks:**

Reconsideration of the present application is respectfully requested. In the Office Action, the examiner rejected claims 1, 5, 6, 11, and 12 as being anticipated by U.S. Patent No. 5,297,796 issued to Peterson. Claims 2-4 were rejected as being unpatentable over Peterson in view of U.S. Patent No. 2,805,071 issued to Kaplan. Claims 7-10, 13-16, and 17-20 were rejected as unpatentable over Peterson in view of U.S. Patent No. 3,936,055 issued to Scott.

New claims 21-37 have been presented which Applicant respectfully suggests are novel and nonobvious considering the references cited.

The claims have been crafted to highlight differences between the present invention and Peterson. One important difference is that the suitcase design of the present invention has been made easily portable by providing it in first and second swingably attached portions. The first portion supports the display. The second portion includes the upper surface upon which a user may stand while swinging. This arrangement is not shown in any of the references.

The references also, as acknowledged by the examiner, fail to "locate the projectile directly above the viewing area" of the display. This highlights a significant shortcoming in Peterson. Peterson dissuades a user from actually hitting a ball. This is because, with the Peterson device, the user is not able to hit the ball off of the display surface. Thus, the Peterson device requires the "golfer to elevate his head to see the monitor" during the swing. See Col. 3, lines 41-47. Thus, Peterson suggests practice swings without the use of a ball in using its device. This, however, deprives the golfer of the tremendous benefit of seeing the result of the swing. For example, trajectory, play, distance, and the ultimate landing spot of the ball.

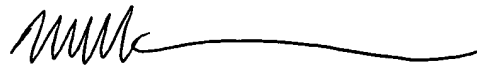
Not so with the user of the present invention. The user of the present invention is able to see the swing in real time on the monitor, and then see the actual result that swing had on the ball. The Peterson user has to make a choice. Whether (i) they want to use a ball and compromise their view of the swing, or (ii) want to use an imaginary ball and be deprived of seeing whether the swing made actually resulted in a good shot. The user of the present invention is, instead, able to adequately view the swing and see the result.

The examiner, with respect to the earlier claims, combined Peterson with Kaplan, or Peterson with Scott. The Applicant believes that the examiner has failed to meet her burden. Missing from the last office action is any evidence showing motivation to combine any of these references. There is nothing in Kaplan, Peterson, or Scott that suggests the combination of any. Peterson is not useable with a tee, and in fact, suggests against actually using a ball, as discussed above. And the combination of Peterson and Scott would defeat the objectives of each. It is fundamental to a finding of obviousness, that the rejection be based on evidence in the record. *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). To support such a rejection, the Examiner must reveal evidence showing that there is a teaching, motivation, or suggestion to select and combine the references relied on. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). This factual inquiry must be thorough. *Id.* Additionally, it must be based on objective evidence in the record. *See Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *In re Dance*, 160 F.3d

1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). The showing must be specific. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (even when the level of skill in the art is high, there must be the identification of a specific the principle, known to one of ordinary skill, that suggests the claimed combination). Instead of presenting objective evidence from the record, the examiner has based the rejections of conclusory statements. These do not suffice, legally speaking.

The application is believed to be in condition for allowance. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action.

Respectfully submitted,



Marshall S. Honeyman  
Reg. No. 48,114

MSH/tjd

SHOOK, HARDY, & BACON L.L.P.  
2555 Grand Blvd.  
Kansas City, MO 64018-2613  
816/474-6550